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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
10 022,862	12 13 2001	Mark G. Obukowicz	PHA 4140.7	4101

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SENNIGER POWERS LEAVITT AND ROEDEL  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER

MELLER, MICHAEL V

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 04 18 2003

97

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

10/022,862

Applicant(s)

OBUKOWICZ ET AL.

## Office Action Summary

Examiner

Michael V. Meller

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1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 24 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) 4-57, 59, 61-96 and 106-112 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-3, 58, 60, 97-105 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

The election of species of record is maintained.

This application contains claims 4-57, 59, 61-96, 106-112 which are drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

Claims 1-3, 58, 60, 97, 98, 100, 104 are rejected under 35 U.S.C. 102(b) as being anticipated by La Hann.

The reference teaches that an ethanol extract of capsaicin is administered parenterally to treat pain. It is inherent that the extract will inhibit COX-2.

Claims 1-3, 58, 60, 97, 98, 100, 104 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2168975.

The reference teaches that an ethanol extract of capsaicin is administered parenterally or orally to treat pain. It is inherent that the extract will inhibit COX-2.

Claims 1-3, 58, 60, 97, 98, 100, 104, 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Byas-Smith.

The reference teaches that an ethanol extract of capsaicin is administered orally to treat arthritis, see col. 4-7, 9. It is inherent that the extract will inhibit COX-2.

Claims 1-3, 58, 60, 97, 98, 100, 104, 105 are rejected under 35 U.S.C. 102(e) as being anticipated by De Lucca, II et al.

The reference teaches that a methanol extract of capsaicin is administered parenterally or orally to treat pain. It is inherent that the extract will inhibit COX-2.

Claims 1-3, 58, 60, 97-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lucca, II et al. or Byas-Smith taken with Hawley's Condensed Chemical Dictionary.

It is clear that the extracts are orally or parenternally administered in the references. It is inherent that the extracts will inhibit COX-2. Applicant argues that there is nothing in the references to show that they treat arthritis, but the claims do not require

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this. The claims only state a patient, the claims never specify that the patient has the disorder, thus the extract could be given to anybody whether they have the condition or not.

Claims 1-3, 58, 60, 97-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Lucca, II et al. or Byas-Smith taken with La Hann or GB 2168975 and Hawley's Condensed Chemical Dictionary.

It is clear that the extracts are orally or parenternally administered in the references. It is inherent that the extracts will inhibit COX-2. Applicant argues that there is nothing in the references to show that they treat arthritis, but the claims do not require this. The claims only state a patient, the claims never specify that the patient has the disorder, thus the extract could be given to anybody whether they have the condition or not.

LaHann and GB show that the extract is noted specifically for treating pain.

Claims 1-3, 58, 60, 97-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holt et al., Stevens, Barr et al. or Caruso in view of La Hann or GB 2,168,975 taken with Hawley's Condensed Chemical Dictionary.

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Claims 1-3, 58, 60, 97-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Hann or GB 2,168,975 taken with Hawley's Condensed Chemical Dictionary.

It is clear that the extracts are orally or parenternally administered in the references. It is inherent that the extracts will inhibit COX-2. Applicant argues that there is nothing in the references to show that they treat arthritis, but the claims do not require this. The claims only state a patient, the claims never specify that the patient has the disorder, thus the extract could be given to anybody whether they have the condition or not.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 703-308-4230. The examiner can normally be reached on Monday thru Friday: 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 703-306-3220. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Michael V. Meller  
Primary Examiner  
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MVM

April 16, 2003